

REMARKS

Applicants respectfully request that this application be reconsidered in view of the above amendments and the following remarks.

1. Status of the Claims

Claims 1-21 are currently pending in the application and are subject to restriction and/or election requirement. Claims 1, 10, 19 and 21 have been amended.

2. Summary of the Amendments

Claims 1, 10 and 21 have been amended such that W cannot be -OR^c. Additionally, Claims 1, 10 and 19 have been amended to correct typographical errors.

Claim 21 has been amended to include definitions of R^c and R^d. Support for this amendment may be found, for example, on page 5, lines 14-21, and page 9, lines 18-25.

Applicants have amended the claims to more clearly define and distinctly claim their invention. No new matter is introduced by the above amendments. Entry of these amendments is respectfully requested.

3. Restriction Requirement

In the April 4, 2003 Office Action, the Examiner has divided the invention into eight different subgenera (G1-8) of formula I:

- G1: R² must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G2: R³ (or R²²) must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G3: R⁴ must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G4: R⁵ (or R²³) must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G5: R⁶ must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G6: R⁷ must be the following, or contain the following: -R^a-Y-R^b(Z)_x
- G7: R¹² (or R²⁷) must be the following, or contain the following: --R^a-Y-R^b(Z)_x , and
- G8: R¹⁵ must be the following, or contain the following: -R^a-Y-R^b(Z)_x.

The Examiner has then further restricted the invention into 17 groups:

1. Claims 1 and 17, drawn to compounds, limited to G1
2. Claims 1-6, 10, 11, 17-18, drawn to compounds, limited to G2
3. Claims 1, 2, 17-18, drawn to compounds, limited to G3
4. Claims 1-5, 10-12, 17-18 drawn to compounds, limited to G4
5. Claims 1, 2, 17-18 drawn to compounds, limited to G5
6. Claims 1, 2, 15-18, drawn to compounds, limited to G6
7. Claims 1, 2, 10, 17, 18 drawn to compounds, limited to G7
8. Claims 1-18 drawn to compounds, limited to G8
9. Claim 22, drawn to compounds
10. Claim 19, drawn to a method of using the compounds of Group 1
11. Claim 19, drawn to a method of using the compounds of Group 2
12. Claim 19, drawn to a method of using the compounds of Group 3
13. Claim 19, drawn to a method of using the compounds of Group 4
14. Claim 19, drawn to a method of using the compounds of Group 5
15. Claim 19, drawn to a method of using the compounds of Group 6
16. Claim 19, drawn to a method of using the compounds of Group 7, and
17. Claim 19, drawn to a method of using the compounds of Group 8.

Applicants note for the record that Claim 21 has not been placed in a group. Applicants respectfully request that it be treated similar to Claim 20.

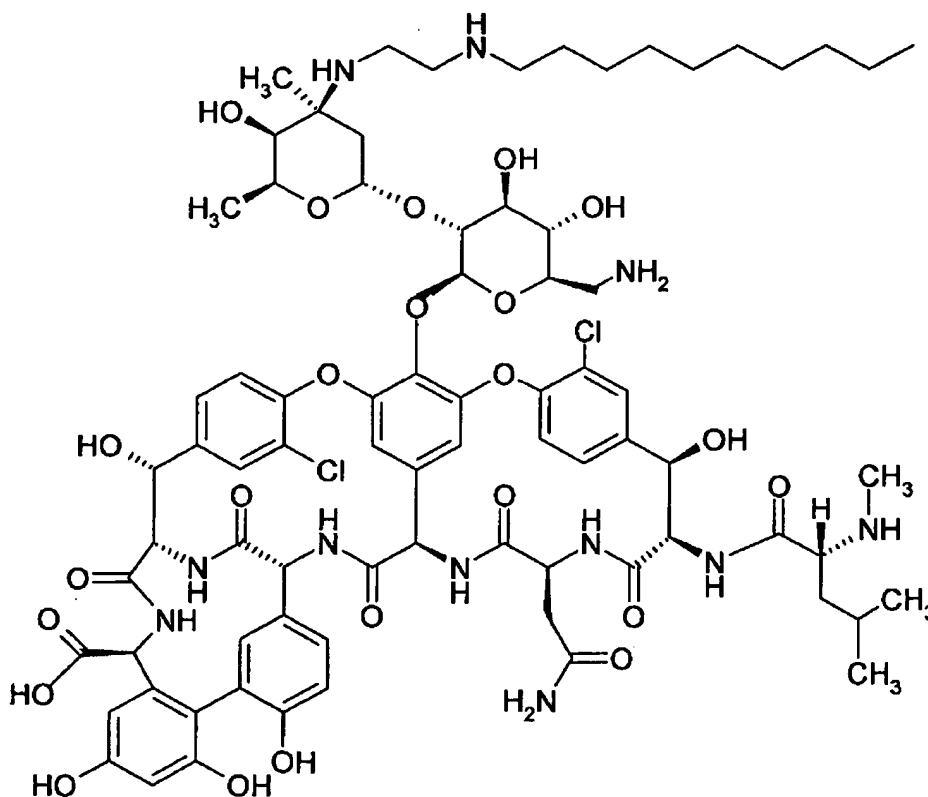
As indicated by the Examiner, Claim 20 has not been placed in any of the defined groups but will be joined with any of Groups 1-8 when one of those groups is elected.

Additionally, the Examiner has provided that in the event that one of Groups 1-8 is elected and the claims therein found allowable, (a) that Claim 19 will be rejoined therewith for further examination and (b) that the possibility of rejoining one or more (of Groups 1-8) may be considered at that time.

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In response to the restriction requirement, Applicants elect Group 8: Claims 1-18 drawn to compounds, limited to G8 (where R^{15} must be the following, or contain the following: $-R^a-Y-R^b(Z)_x$) with traverse.

Group 8 includes generic Claim 1, which reads on the Claims of Groups 2-8. Claim 1, therefore, is a linking claim of type (A) "genus claims linking species claims", as defined in MPEP §809.03. It is Applicants' understanding, that according to MPEP §809, if genus Claim 1 is allowed, the restriction requirement with respect to Groups 2-8 is to be withdrawn.

In response to the election of species requirement, Applicants elect compound 1 described as compound "no. 1" in the table found on page 17 of the specification, wherein R^{15} is $-\text{CH}_2\text{CH}_2-\text{NH}-(\text{CH}_2)_9\text{CH}_3$; R^{17} is H; W is $-\text{NH}_2$, and R^{22} is $-\text{OH}$. For the Examiner's convenience, Compound 1 is drawn below. Claims 1-20 read on the elected species.



Applicants respectfully traverse the restriction requirement for the following reasons.

The present restriction requirement appears to be an attempt by the Examiner to define inventions within individual claims. Applicants submit that it is clearly established that the USPTO cannot require an applicant, under the guise of §121, to divide up the embodiments of a single Markush claim. Specifically, the Court of Customs and Patent Appeals has clearly stated:

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *In re Weber*, 198 USPQ 328, 331 (CCPA 1978) (emphasis in original).

The Examiner's attention is further directed to MPEP §803.02 where restriction practice with respect to Markush claims is discussed in connection with the decision in *In re Weber*. In particular, MPEP §803.02 states:

Since the decisions in *In re Weber*... it is improper for the office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Unity of invention exists in generic Claim 1. The compounds included in Claim 1 share a common utility (antibacterial activity) and share a substantial structural feature disclosed as being essential to that utility. Since Claim 1 demonstrates unity of invention as defined in *In re Weber*, "it is improper for the office to refuse to examine that which applicants regard as their invention."

Applicants believe that because of the close structural similarity between the compounds of Claim 1, that searching the invention as a whole would not be an undue burden on the Examiner.

For at least the reasons described herein, Applicants respectfully request that the Restriction Requirement be withdrawn.

Entry of the above amendments prior to examination is respectfully requested.

Respectfully submitted,

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